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**THIS DISPOSITION
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Paper No. 9
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **SnapTrack, Inc.**

Serial No. 75/548,099

Lori M. Stockton and Lori N. Boatright of Blakely,
Sokoloff, Taylor & Zafman for applicant.

James A. Rauen, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Simms, Cissel and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by SnapTrack, Inc. to register the mark SMARTSERVER for "global positioning systems hardware and software, namely gps circuits, hand-held receivers, antenna, modems, displays, transmitters, processors, mobile receivers, ground station receivers, satellites, base station systems in the nature of computer servers and relays, network of reference gps receivers, operating software for use therewith, and gps software in the nature of navigation, location, tracking, mapping and

timing software; telecommunications systems in the nature of satellites, wireless handsets, receivers and gps technology incorporated therewith for use in a wireless network" (in International Class 9) and "communications services and telecommunications services namely using global positioning systems to provide for navigation, location, tracking, mapping and timing objectives for users; providing the electronic transmission of data and voice via global communications network and wireless networks; providing telecommunications connections to a global computer network; electronic transmission of voice messages and data by telephone or network communications" (in International Class 38).¹

The Trademark Examining Attorney refused registration under Section 2(d) on the ground of likelihood of confusion with two previously issued registrations, owned by different entities. The cited marks are SMARTSERVE for "maintenance and/or repair of telecommunications equipment"² and the mark shown below

¹ Application Serial No. 75/548,099, filed September 4, 1998, based on an allegation of a bona fide intention to use the mark in commerce.

² Registration No. 1,924,803, issued October 3, 1995.

for "communications services, namely, providing access to data processing and communications platforms that link businesses, consumers and professionals to information service and transactional service providers."³

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that applicant's mark is similar to each of the cited marks, and that the goods and services sold thereunder are related, all being in the telecommunications field. The Examining Attorney is not persuaded by the coexistence of the cited registrations and the third registration which applicant later introduced. In connection with the relatedness of the goods and services, the Examining Attorney relied upon third-party registrations, which show, according to the Examining Attorney, that the same entity has registered the same mark for the types of goods and services involved in this appeal. The Examining Attorney also introduced excerpts from the Yellow Pages telephone directory showing listings of companies which offer both telecommunications equipment and maintenance thereof.

³ Registration No. 2,115,466, issued November 25, 1997. The term "Online" is disclaimed apart from the mark.

Applicant contends that there are differences between its mark and the cited marks, and that the cited marks are more similar to one another than they are to applicant's mark. In this connection, applicant points to the coexistence of the two cited marks, as well as a third registered mark that it introduced during the prosecution of this application. Applicant further argues that there are significant differences, including channels of trade, between its goods and services and the services recited in each of the cited registrations. Applicant asserts that consumers of global positioning systems are sophisticated and knowledgeable and are very focused on their specialized needs. Attached to applicant's reply brief is a dictionary listing of the term "global positioning system," commonly referred to as "gps," of which we take judicial notice. The term is defined, in part, in *Newton's Telecom Dictionary* (15th ed. 1999) as follows:

A system to allow us all to figure out precisely where we are anywhere on earth. The GPS will eventually consist of a constellation of 21 satellites orbiting the earth at 10,900 miles-- they circle the earth twice a day. In a way, you can think of them as "man-made stars" to replace the stars that we've traditionally used for navigation...we figure our position on earth by measuring our distance from a group of satellites in space. The

satellites act as precise reference points.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Registration No. 1,924,803

We first turn to compare the marks SMARTSERVER and SMARTSERVE. The marks are virtually identical in terms of sound, appearance and meaning, the only difference being the additional last letter "r" in applicant's mark. Although there is a suggestive quality to the marks, the record lacks evidence of third-party uses or registrations in the telecommunications field other than the two cited marks and one third-party registration introduced by applicant. We find that the involved marks are similar so that, if applied to related goods and/or services, confusion would be likely to occur.

Insofar as the goods and services are concerned, we start with the premise that they need not be identical or even competitive to support a holding of likelihood of confusion. It is sufficient that the goods and/or services are so related or that conditions surrounding their marketing are such that they are encountered by the same persons who, because of the relatedness of the goods and/or services and the similarities between the marks, would believe mistakenly that the goods and/or services originate from or are in some way associated with the same source. See, e.g., *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Registrant's "maintenance and/or repair of telecommunications equipment" services are not limited and, therefore, the services are broad enough to include maintenance and repair of global positioning telecommunications systems of the type intended to be sold by applicant. See: *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)[it is presumed that in scope the registration encompasses all types of such services, and that the services move in all channels of trade that would be normal for such services and that they would be purchased by all potential buyers thereof]. The evidence

submitted by the Examining Attorney (Yellow Pages listings and third-party registrations) suggests that the same entities offer both telecommunications equipment and maintenance/repair thereof under the same mark.⁴ See: In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Further, registrant's services are related to applicant's services of "providing the electronic transmission of data and voice via global communications network and wireless networks; providing telecommunications connections to a global computer network; [and] electronic transmission of voice messages and data by telephone or network communications." Registrant's recitation of services is broad enough, as indicated above, to cover maintenance of the type of equipment used in the rendering of applicant's telecommunications services. Thus, the same classes of purchasers would be encountering the virtually identical marks.

Given the similarities between the marks and goods and/or services as discussed above, the possible sophistication of purchasers would not ensure against the likelihood of confusion. Firstly, there is no support in

⁴ In considering this evidence, we recognize that none of the examples involves global positioning systems.

the record for applicant's assertions regarding the purported sophistication of purchasers. Moreover, telecommunications goods and services of the type involved here undoubtedly are offered to a wide range of consumers, not all of whom are likely to be knowledgeable in the field.

Registration No. 2,115,466

Although there are differences between applicant's mark SMARTSERVER and registrant's mark SMARTSERV ONLINE and design, the differences are outweighed by the points of similarity. Registrant's mark is dominated by the term "SMARTSERV." This dominant portion is virtually identical to applicant's mark SMARTSERVER, differing only in the last two letters "er." Being the first term in registrant's mark, it is the portion that is most likely to be remembered by consumers and to be used in calling for the services. Further, although we have considered the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with

respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751.

With respect to registrant's mark, the disclaimed term "Online" clearly is generic and subordinate to the term "SMARTSERV." Although we have considered the disclaimed portion of registrant's mark, as well as the design feature, we do not find that they distinguish registrant's mark from applicant's mark in any meaningful way.

In sum, the general overall commercial impressions engendered by the marks are similar such that, if the marks were used in connection with similar goods and/or services, confusion would be likely to occur.

Registrant's services are identified as "communications services, namely, providing access to data processing and communications platforms that link businesses, consumers, and professionals to information service and transactional service providers." We find that these services are similar to applicant's communications and telecommunications services. More specifically, applicant's Class 38 services, as worded, are substantially

similar, if not virtually identical, to registrant's services.⁵

Given the similarities between the marks and goods and/or services as discussed above, the possible sophistication of purchasers, as in the case with the other cited registration, would not ensure against the likelihood of confusion. Firstly, there is no support in the record for applicant's assertions regarding the purported sophistication of purchasers. Moreover, telecommunications goods and services of the type involved here undoubtedly are offered to a wide range of consumers, not all of whom are likely to be knowledgeable in the field.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

⁵ We suppose that this was the genesis of applicant's suggestion in its reply brief that the Class 38 services be amended to indicate that they are offered for "global positioning." An amendment at this late juncture of the appeal process is not warranted. Further, registrant's services are not restricted to any specific type of communications services and, thus, are broad enough to encompass such services relating to global positioning telecommunications services.

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Decision: The refusals to register are affirmed.